

REMARKS

Applicant has carefully studied the Office Action of January 9, 2004 and offers the following remarks thereto.

The pending claims were rejected under 35 U.S.C. § 103. However, in constructing the rejections, the Patent Office has overlooked two very important limitations on creating obviousness rejections under 35 U.S.C. § 103. First, the Patent Office must articulate a reason to combine the references. This is sometimes referred to as the motivation to combine the references. When the Patent Office articulates a motivation to combine the references, the Patent Office must support this motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). While the law allows for multiple sources of this evidence, the fact that the motivation can come from the knowledge of one of ordinary skill in the art does not diminish the need for actual evidence to support the motivation. *Id.* Second, even if the Patent Office supports the motivation to combine with actual evidence, the combination cannot render the references unsuitable for their intended purposes. MPEP § 2143.01. If the combination does render a reference unsuitable for its intended purpose, the combination is improper and obviousness is not established.

In the present case, the Patent Office has rejected claims 47, 48, 50-61 and 63-72 under 35 U.S.C. § 103(a) as being unpatentable over Inniss et al. (hereinafter "Innis") in view of Kanevsky et al. (hereinafter "Kanevsky") and Fenton. Applicant respectfully traverses.

With respect to independent claims 47 and 59, the Patent Office admits that Inniss does not show all the claim elements and relies on Kanevsky to show the index file and Fenton to show the gateway recited in the claims. The Patent Office, at the bottom of page 4 and top of page 5 of the Office Action of January 9, 2004, opines that it would be obvious to modify the Inniss system by indexing and sending the audio data to a gateway so an audio message could be searched, retrieved by a recipient in a circuit-switched telephone network. Without admitting the propriety of this motivation, Applicant notes that there is no evidence to support this motivation. As such, the motivation is not sufficient and the references are not properly combinable to support the rejection. Since the references are not properly combinable, the references must be considered individually. The Patent Office admits that individually the references do not have all the claim elements and thus, individually, the references do not establish obviousness. Since

the references do not establish obviousness for the independent claims 47 and 59, the references cannot establish obviousness for the dependent claims.

As further evidence that the references are not properly combinable, Applicant notes that the intended purpose of Inniss is to convey messages to multiple recipients via voice mail (see Inniss, col. 1, lines 18-58). Specifically, the purpose of Inniss is to send repetitive messages from an originator to multiple recipients. The example given is a repeated introductory phrase, followed by a customized middle portion, and a repeated closing phrase. Furthermore, Inniss declares at col. 2, lines 30-36 that an object of the invention is to permit a recipient to request a selected distribution of pre-recorded messages from the originator. If Inniss is modified to send the audio file to the gateways, then the system no longer works in a voice mail system and no longer permits a recipient to request messages from the originator (rather they would request from the gateway). To this extent, the proposed modification of Inniss to include Kanevsky and Fenton makes Inniss unsuitable for its intended purpose. To this extent, the combination is improper and the references must be considered individually. As previously discussed, the references individually do not support the rejection and thus the claims are patentable.

Dependent claims 48, 50-58, 60, 61, and 63-72 are patentable at least for the same reasons that independent claims 47 and 59 are patentable.

Claims 49 and 62 were rejected under 35 U.S.C. § 103 as being unpatentable over Inniss in view of Kanevsky, Fenton and Baber et al. (hereinafter "Baber"). Applicant respectfully traverses.

Initially, Applicant notes that this relies on the same underlying combination addressed above. The Patent Office does not expand on the motivation to combine Inniss, Kanevsky and Fenton, or address the rendering of Inniss unsuitable for its intended purpose, so those arguments remain applicable to this combination. The Patent Office admits that Inniss, Kanevsky and Fenton do not teach the index file being adapted to map an audio identifier of the audio segment to an offset and length of the audio segment, and relies on Baber for this element. The reason the Patent Office gives for the combination is to search and retrieve indexed information in an index file. Again, there is no evidence provided to support this combination, and thus, the combination is improper. The Patent Office is not free to ignore the instructions of the Federal Circuit on this point, and absent such actual evidence, the rejection fails.

Applicant requests reconsideration of the rejection in light of the remarks presented herein. The combination proposed by the Patent Office has not been properly supported with the requisite evidence, and further, the combination makes the primary reference unsuitable for its intended purpose. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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